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10/022,143	12/13/2001	Herbert Peiffer	00/172 MFE	2770

7590

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EXAMINER

CHEN, VIVIAN

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 06/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,143

Applicant(s)

PEIFFER ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 9, 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL) for the reasons set forth in the previous Office Action. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,423,401 (PEIFFER ET AL) claims a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, and process of making (patent claims 1-7,10) as recited in the application claims 1-7, 9. However, the patent does not explicitly claim the recited haze or gloss values.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional finishing methods and/or additives to modify the clarity

and the surface texture of the film in order to obtain the specific gloss (or lack thereof) and light transmittance properties desired for a given usage. It is well known in the art to use polyester films in packaging applications.

3. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL), and further in view of FUNDERBURK ET AL (US 4,493,872) or PEIFFER ET AL (US 6,214,440) for the reasons set forth in the previous Office Action.

U.S. Patent No. 6,423,401 (PEIFFER ET AL) as relied upon above.

FUNDERBURK ET AL discloses that it is well known in the art to apply a sulfonated copolyester coating derived from 65-96 mol% isophthalic acid, 0-30 mol% of the recited aliphatic dicarboxylic acid, 5-15 mol% of the recited sulfomonomer, and stoichiometric amounts of the recited glycols in order to improve the adhesive properties of polyester films. PEIFFER ET AL '440 discloses that it is well known in the art to apply a sulfonated copolyester surface layer having the composition recited in claim 8 to a polyester film in order to improve the adhesive properties of the polyester film.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the adhesion promoting copolyester of FUNDERBURK ET AL or PEIFFER ET AL '440 in the surface layer of the film claimed in U.S. Patent No. 6,423,401 (PEIFFER ET AL) in order to improve the adhesion properties of the film.

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4. Claims 10-12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,423,401 (PEIFFER ET AL), and further in view of HIBIYA ET AL (US 6,136,420) for the reasons set forth in the previous Office Action.

U.S. Patent No. 6,423,401 (PEIFFER ET AL) as relied upon above.

HIBIYA ET AL discloses that it is well known in the art to heat-set polyester films at the conditions recited in claim 10 (lines 49-63, col. 16) in order to improve dimensional stability and to subject the film to conventional adhesion promoting treatments such as corona discharge prior to coating in order to enhance interlayer adhesion (lines 22-59, col. 14). The reference also discloses that it is well known in the art to incorporate scrap material into the film in typical amounts of 5-60 wt% in order to reduce material costs and waste generation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional heat-setting and adhesion promoting treatments as disclosed in HIBIYA ET AL on the film claimed in U.S. Patent No. 6,423,401 (PEIFFER ET AL) in order to improve the adhesiveness and the stability of the film. It also would have been obvious to recycle scrap film material for economic and environmental reasons. One of ordinary skill in the art would have adjusted the adhesion promoting treatment to optimize the surface tension for a specific coating material as indicated in claim 11.

5. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application 10/182,294

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(PEIFFER ET AL) or 10/182,317 (PEIFFER ET AL) in view of PEIFFER ET AL (US 5,955,181)

The above copending Applications each claim a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, and process of making. However, the patent does not explicitly claim the recited haze, gloss, film orientation methods or use of regrind.

PEIFFER ET AL '181 discloses conventional orientation conditions for polyester films and antiblocking agents (lines 55-68, col. 6; column 8) typically used to obtain improved mechanical and surface properties of the film in addition to the use of regrind in order to reduce waste material.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional finishing methods and/or additives to optimize the clarity and the surface texture of the film in order to obtain the specific gloss (or lack thereof) and light transmittance properties desired for a given usage.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GERMAN PATENT APPLICATIONS 100 07 723 A1 or 100 07 725 A1 or 100 07 722 A1 (hereinafter DE '723 or DE '725 or DE '722, respectively) or WO 01/60900 A1 or WO 01/60610 or WO 01/60613.

The above references each disclose a multilayer film having the recited base layer B, sealable outer layer A and cover layer C, said layers having the minimum heat sealing temperature, seal seam strength, surface gas-flow, particle contents, polyester materials, gloss, haze, and process of making as recited in the application claims 1-7, 9. (DE '722, entire document, specifically Table 1, claims, etc.) (see corresponding portions of the other references)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the surface properties of the prior art films in order to obtain the specific film handling and optical properties required by a given end use.

Response to Arguments

8. Applicant's arguments filed 3/28/2003 have been fully considered but are not deemed persuasive for the following reasons:

(A) Applicant argues that PEIFFER ET AL '401 fails to claim the recited invention. Applicant further contends that the Ra and gloss values of the PEIFFER ET AL '401 film do not overlap with the claimed invention. However, with respect to the Ra values, contrary to Applicant's assertion, the film in the present application has a minimum Ra value of 150 nm which overlaps the range of Ra values in the '401 patent (i.e., an Ra value up to *and including* 150 nm); therefore, while the majority of the Ra value ranges in the application and the '401

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patent may differ, the film of the '401 patent has Ra values which encompass those recited in the application claims.

In regard to the haze values, the *claims* of the '401 patent are silent with respect to gloss, and therefore the language of the patent claims encompass films of both high and low gloss values. While Applicant argues that there is no motivation to reduce the gloss of the '401 films, it is the Examiner's position that gloss is a surface property that is readily modified, (in this case reduced), by one of ordinary skill in the art using conventional methods in order to obtain specific decorative or aesthetic effects for various applications (e.g., non-glossy labels, packaging, display devices, etc.). Applicant has not provided any probative evidence to the contrary.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (for non-after finals) and (703) 872-9311 (for after-finals).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

June 13, 2003



Vivian Chen
Primary Examiner
Art Unit 1773